

REMARKS

1. Status of the Claims and Claim Numbering

In the Notice, the Examiner asserts that the status of claims as indicated in Applicant's previously reply of November 11, 2008 is incorrect. Specifically, the Examiner alleges that the status of claims 40-42 is incorrect because only claims 1-39 were present in the amendment filed on April 21, 2008 (the "April 2008 Reply"). As discussed in the Reply filed February 9, 2009, the error in claim numbering was introduced in the Reply filed April 21, 2008.

The undersigned would like to thank the Examiner for the courtesy of the telephone call to discuss the most expedient manner of correcting the claim numbering and status. As requested by the Examiner, the Applicant is hereby amending the claims to add claims 41 and 42 as new. At the same time, the Applicant is amending claims 21 and 36 are amended. Applicant brings to the attention of the Examiner that the amendment to claim 21 differs from the Reply filed November 11, 2008. Upon entry of the amendments, claims 21, 23, 35, 36, 41 and 42 will be pending and under active consideration. Applicant respectfully requests entry of the amendments and remarks made herein into the file history of the application.

2. Patentability Remarks

a. 35 U.S.C. § 102

On page 3 of the Office Action mailed September 30, 2008, the Examiner rejects claim 41 under 35 U.S.C. § 102(b) as allegedly being anticipated by Fodor *et al* (US 2001/0053519 A1; "Fodor"). Amended claim 42 is related to a probe including a viral insert of 24 nucleotides in length. Fodor allegedly teaches a nucleic acid of 25 nucleotides with each nucleotide being A, C, T (or U), or G. Such a nucleic acid would have over 1.12×10^{15} possible sequences. The Examiner asserts that the specific sequence of the claimed probe is somehow taught by the vast number of sequences that may possibly be derived from Fodor. Applicant respectfully disagrees.

The specific sequences of SEQ ID NOS: 477, 480, or 482 are not disclosed in Fodor, nor is any sequence in Fodor even remotely similar to these sequences. There is also no teaching or suggestion in Fodor to isolate or select the specific sequence of SEQ ID NO: 477, 480, or 482 from the 1.12×10^{15} sequence choices of Fodor. Therefore, the probe of amended claim 42 is not anticipated because one of skill could not at once envisage the claimed sequence from among the near endless number of possible sequences taught by Fodor. See MPEP § 2131.02, citing *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) and *In re Petering*, 301 F.2d 676, 133 USPQ 275

(CCPA 1962). Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 42 under 35 U.S.C. § 102 over Fodor.

b. 35 U.S.C. § 103

On pages 3 and 4 of the Office Action mailed September 30, 2008, the Examiner rejects claim 36 as allegedly being unpatentable over Fodor. The Examiner asserts that it would have been obvious to make a vector comprising SEQ ID NOs: 477, 480, or 482 because it was known to insert the probe allegedly taught by Fodor into a vector. As discussed above, Fodor does not teach or suggest the specific sequence of SEQ ID NO: 477, 480, 482, or any remotely similar sequence from the 1.12×10^{15} possible sequences that could be generated from the 25-mer of Fodor. This fundamental defect of Fodor is not remedied by Fodor's alleged teaching to insert probe sequences into a vector. Accordingly, Fodor does not teach or suggest all the limitations of claim 36. In view of the foregoing remarks, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 36 under 35 U.S.C. § 103 over Fodor.

3. Conclusion

Applicant respectfully submits that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

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